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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,098	10/14/2003	Nobuhiro Itoh	2271/71239	4451
7590 Ivan S. Kavrukov, Esq. Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			EXAMINER FACTOL, NICHOLAS C	
			ART UNIT 4178	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/685,098

Applicant(s)

ITO, NOBUHIRO

Examiner

Nicholas C. Pachol

Art Unit

4178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on November 20, 2007 have been fully considered but they are not persuasive.

In regards to claims 1, 11, 14 and 24, the examiner will address the arguments in view of claim 1. Claim 1 is rejected as Cairo in view of Chen. Cairo was used to teach a facsimile apparatus to certify the delivery of a transmission. Cairo discloses the apparatus that performs the functions of notifying a communication result notification.

Chen teaches the name storage section to store the destination names and identifying these names through the caller response unit. This allows the device to identify the sender or receiver.

Therefore, the combination of Cairo and Chen teaches all the limitations of the claim.

2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "if the receiving end is registered as one of the specific destinations") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As such, Applicant's argument "Cairo fails to disclose or suggest that if the receiving end is registered as one of the specific destinations, a communication result

notification is output after the transmission (since Cairo does not even teach registering the specific destinations information)" is moot.

3. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant states that both Cairo and Chen "do not disclose or suggest identifying a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end." In response, the examiner did not rely on Chen to disclose this limitation but Cairo discloses this limitation because when a facsimile transmission is sent, the sender has to receive information from the receiving in order to establish a connection with the receiver. If no confirmation is sent back for the initial set up of the network between the sender and receiver, then there can be no facsimile transmission.

The examiner respectfully disagrees in regards that Chen does not disclose "outputting a communication result notification indicative of the facsimile transmission to the receiving end ..." because Chen discloses checking to confirm if a caller is on the list of expected callers. Chen then further discloses in page 1, paragraph 27 that if the caller matches a caller stored in the list, then an announcement, communication result, is made.

In view of that, the combination of Cairo in view of Chen meets all the limitations claimed in claims 1, 11, 14 and 24. Thus, the examiner maintains the rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cairo (US 5,809,116) in view of Chen (US 2002/0094076).

Regarding Claim 1, Cairo teaches a facsimile apparatus (Column 5, lines 33-35) comprising: a receiving end identifying section to identify a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 2, element 30 and Column 5, lines 39-42);

and a notifying section to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the specific destination name storage section (Column 5, lines 49-56 and Column 5, lines 59-66).

However Cairo does not teach a specific destination name storage section to store destination names of specific destinations and a specific destination identifying section to search from the specific destination name storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section.

Chen does teach a specific destination name storage section to store destination names of specific destinations (Page 1, Paragraph 25) and a specific destination identifying section to search from the specific destination name storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section (Page 1, Paragraph 25), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Chen for the purpose of providing clarity in caller identification (Column 1, Paragraph 6).

Regarding Claim 2, Cairo further teaches wherein the notifying section outputs a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage section (Column 2, lines 49-54).

Regarding Claim 3, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 4, Cairo further teaches wherein the notifying section displays or prints the communication result report (Column 5, lines 62-67).

Regarding Claim 5, Chen further teaches wherein the notifying section outputs a transmission end sound for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage section (Page 1, Paragraph 27).

Regarding Claim 6, Chen further teaches wherein the transmission end sound is set differently for each specific destination (Page 1, paragraph 26 where index code indicates that the sound can be different and Page 3, paragraphs 67-68).

Regarding Claim 11, Cairo teaches a facsimile apparatus comprising: receiving end identifying means for identifying a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 2, element 30 and Column 5, lines 39-42); and notifying means for outputting a communication result notification indicative of a result of the facsimile

transmission to the receiving end only when the specific destination identifying means finds the corresponding destination name in the specific destination name storage means (Column 5, lines 49-56 and Column 5, lines 59-66).

However Cairo does not teach a specific destination name storage means for storing destination names of specific destinations and specific destination identifying means for searching from the specific destination name storage means a destination name corresponding to the receiving end which is identified by the receiving end identifying means.

Chen does teach a specific destination name storage means for storing destination names of specific destinations (Page 2, Paragraph 51) specific destination identifying means for searching from the specific destination name storage means a destination name corresponding to the receiving end which is identified by the receiving end identifying means (Page 2, Paragraphs 42 and 43), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Chen for the purpose of providing clarity in caller identification (Page 1, Paragraph 6).

Regarding Claim 12, Chen further teaches wherein the notifying means makes the communication report notification by one or an arbitrary combination of communication report notifications selected from a group consisting of outputting a communication result report, outputting a transmission end sound, and printing a stamp

mark on a scanned document, for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage means (Paragraph 28 and Paragraphs 72-74, where having the option to choose between a song and a display and none at all makes it inherit to have the choice of a stamp, a sound, or a result report).

Regarding Claim 14, Cairo teaches a facsimile communication method comprising: identifying a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 1); and outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the corresponding destination name is found in the storage section (Figure 1 and Figure 2).

However Cairo does not teach storing destination names of specific destinations in a storage section and searching from the storage section a destination name corresponding to the receiving end which is identified.

Chen does teach storing destination names of specific destinations in a storage section (Page 2, Paragraph 51) and searching from the storage section a destination name corresponding to the receiving end which is identified (Page 2, Paragraph 57), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Chen for the purpose of providing clarity in caller identification (Page 1, Paragraph 6).

Regarding Claim 15, Cairo further teaches wherein the outputting outputs a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Column 8, lines 5-15).

Regarding Claim 16, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 17, Cairo further teaches wherein the outputting displays or prints the communication result report (Column 8, lines 61-65).

Regarding Claim 18, Chen further teaches wherein the outputting outputs a transmission end sound for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Page 1, Paragraph 27).

Regarding Claim 19, Chen further teaches wherein the transmission end sound is set differently for each specific destination (Page 1, paragraph 26 where index code indicates that the sound can be different and Page 3, paragraphs 67-68).

Regarding Claim 24, the computer readable storage medium which stores a program is treated as a method. Cairo does teach a receiving end identifying procedure causing the computer to identify a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 1); and a notifying procedure causing the computer to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the storage section (Figure 1 and Figure 2).

However Cairo does not teach a specific destination name storage procedure causing the computer to store destination names of specific destinations in a storage section and a specific destination identifying procedure causing the computer to search from the storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section.

Chen does teach a specific destination name storage procedure causing the computer to store destination names of specific destinations in a storage section (Page 2, Paragraph 51) and a specific destination identifying procedure causing the computer to search from the storage section a destination name corresponding to the receiving

end which is identified by the receiving end identifying section (Page 2, Paragraph 57), therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Chen for the purpose of providing clarity in caller identification (Page 1, Paragraph 6).

Regarding Claim 25, Cairo further teaches wherein the notifying procedure causes the computer to output a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Column 8, lines 5-15).

Regarding Claim 26, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 27, Cairo further teaches wherein the notifying procedure causes the computer to display or print the communication result report (Column 8, lines 61-65).

Regarding Claim 28, Chen further teaches wherein the notifying procedure causes the computer to output a transmission end sound for each facsimile

transmission made to the receiving end having the corresponding destination name stored in the storage section (Page 1, Paragraph 27).

Regarding Claim 29, Chen further teaches wherein the transmission end sound is set differently for each specific destination (Page 1, paragraph 26 where index code indicates that the sound can be different and Page 3, paragraphs 67-68).

Regarding Claims 7, 20, and 30, Chen further teaches wherein the notifying section, as described in claims 1, 14, and 24, prints a stamp mark on a scanned document for each facsimile transmission made to the receiving end (Column 4, line 60 – Column 5, line 4 and Column 5, lines 33-38, where stamp mark can be anything printed on the scanned document, i.e. indicia of delivery) having the corresponding destination name stored in the specific destination name storage section (Column 2, lines 50-53).

Regarding Claims 8, 21, and 31 Chen further teaches wherein the stamp mark, as disclosed in claims 7, 20, and 30, is set differently for each specific destination (Column 2, lines 50-53).

Regarding Claims 9, 22, and 32 Chen further teaches wherein the notifying section, as described in claims 1, 14, and 24, makes the communication report

notification by one or an arbitrary combination of communication report notifications selected from a group consisting of outputting a communication result report, outputting a transmission end sound, and printing a stamp mark on a scanned document, for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage section (Paragraph 28 and Paragraphs 72-74, where having the option to choose between a song and a display and none at all makes it inherit to have the choice of a stamp, a sound, or a result report).

Regarding Claims 10, 13, and 23, and 33 wherein the communication result report, the transmission end sound, and the stamp mark are set differently for each specific destination as described in claims 9, 12, 22, and 32, (see rejections for claim 3 for the communication result report, claim 6 for transmission end sound, and claim 8 for stamp mark as described in claims 9 and 12).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-T, 7:00 a.m.-5:30 p.m. (EST), Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NP
01/10/08

/Hai Tran/
Supervisory Patent Examiner, Art Unit 4178